



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,098	02/05/2001	Robert Bernstein	4707-81342	1323

7590 03/12/2004

Welsh & Katz, Ltd
Jon P. Christensen
22nd Floor
120 South Riverside Plaza
Chicago, IL 60606

EXAMINER

YOUNG, JOHN L

ART UNIT PAPER NUMBER

3622

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,098

Applicant(s)

BERNSTEIN, ROBERT

Examiner

John L. Young

Art Unit

3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Serial Number: 09777,098

Berstein

Art Unit: 3622

FIRST ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful
process, machine, manufacture, or composition of matter or
any new and useful improvement thereof, may obtain a
patent therefore, subject to the conditions and requirements
of this title.

2 Claims 1-16, are rejected under 35 U.S.C. 101, because the claims are directed to non-statutory subject matter.

As per independent claims 1-16, as drafted said claims are not
within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972);

Serial Number: 09/777,098 (Bernstein)

Art Unit: 3622

In re Musgrave, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b) albeit limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75 , 47 USPQ 2d at 1602 (Fed Cir. 1998) ; *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999); and said claims suffer from undue-breadth.

It is well settled in the law that "Undue breadth of the claim may be addressed under different statutory provisions, depending on the reasons for concluding that the claim is too broad. If the claim is too broad because it does not set forth that which applicants regard as their invention. . . . a rejection under 35 U.S.C. 112, second paragraph would be appropriate. . . . If the claim is too broad because it reads on the prior art, a rejection under either 35 U.S.C. 102 or 103 would be appropriate." (See MPEP 2173.04 Breadth Is Not Indefiniteness (August 2001) p. 2100-195).

Furthermore, it is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05(q)).

Serial Number: 09/777,098

(Bernstein)

Art Unit: 3622

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-22 are rejected under 35 U.S.C. §103(a) as being obvious over Deaton US 6,516,302 (02/04/2003) [US f/d: 10/12/1999] (herein referred to as "Deaton").

As per claim 1, Deaton (col. 69, ll. 13-22) discloses: "*The present system provides automatically printed coupons at the point-of-sale . . . which are targeted to a customer based upon his prior shopping history. . . .*"

Art Unit: 3622

Deaton (col. 92, ll. 6-15) discloses: *"FIG. 37 is a program flow diagram illustrating the building of a profile value which is based upon items purchased by a customer."*

Deaton (col. 127, ll. 50-55; and col. 132, ll. 50-60) discloses: *"electronic mail may be sent to. . . [a] customer. . . ."*

Deaton (col. 128, ll. 25-45) discloses: *"system 320 does not suffer from potential fraud. . . the store can verify that the incentive is utilized by the correct customer. . . ."*

Deaton (col. 69, ll. 13-22; col. 92, ll. 6-15; col. 127, ll. 50-55; col. 132, ll. 50-60; col. 128, ll. 25-45; FIG. 37; FIG. 2A; FIG. 30; FIG. 31; FIG. 44B; FIG. 1; FIG. 17B; FIG. 21; FIG. 46; FIG. 48A; FIG. 47; Fig. 52; FIG. 54; FIG. 58A; col. 101, ll. 60-67; col. 102, ll. 1-67; col. 103, ll. 1-67; col. 104, ll. 1-67; col. 105, ll. 1-67; col. 106, ll. 1-67; col. 107, ll. 1-67; col. 108, ll. 1-67; col. 109, ll. 1-67; col. 110, ll. 1-67; col. 111, ll. 1-40; and whole document) shows "A method for identifying potential customers for delivery of promotional materials, such method comprising the steps of: forming a customer profile by a vendor for targeting delivery of the promotional materials to potential customers; identifying customers which match the customer profile within a database of a third party; and forwarding promotional materials to the identified customers."

Deaton lacks an explicit recitation of the elements and limitations of claim 1, even though Deaton (col. 69, ll. 13-22; col. 92, ll. 6-15; col. 127, ll. 50-55; col. 132, ll. 50-60; col. 128, ll. 25-45; FIG. 37; FIG. 2A; FIG. 30; FIG. 31; FIG. 44B; FIG. 1; FIG. 17B; FIG. 21; FIG. 46; FIG. 48A; FIG. 47; Fig. 52; FIG. 54; FIG. 58A; col. 101, ll. 60-

Art Unit: 3622

67; col. 102, ll. 1-67; col. 103, ll. 1-67; col. 104, ll. 1-67; col. 105, ll. 1-67; col. 106, ll. 1-67; col. 107, ll. 1-67; col. 108, ll. 1-67; col. 109, ll. 1-67; col. 110, ll. 1-67; col. 111, ll. 1-40; and whole document) suggests same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Deaton (col. 69, ll. 13-22; col. 92, ll. 6-15; col. 127, ll. 50-55; col. 132, ll. 50-60; col. 128, ll. 25-45; FIG. 37; FIG. 2A; FIG. 30; FIG. 31; FIG. 44B; FIG. 1; FIG. 17B; FIG. 21; FIG. 46; FIG. 48A; FIG. 47; Fig. 52; FIG. 54; FIG. 58A; col. 101, ll. 60-67; col. 102, ll. 1-67; col. 103, ll. 1-67; col. 104, ll. 1-67; col. 105, ll. 1-67; col. 106, ll. 1-67; col. 107, ll. 1-67; col. 108, ll. 1-67; col. 109, ll. 1-67; col. 110, ll. 1-67; col. 111, ll. 1-40; and whole document) would have been modified and selected in accordance with the elements and limitations of claim 1 because modification/selection of the disclosure of Deaton would have provided means for conducting *"differentiated customer promotion. . . ."* (See Deaton (col. 1, ll. 48-67)).

As per claims 2-8, Deaton shows the method of claim 1 and subsequent claims depending from claim 1.

Deaton (col. 69, ll. 13-22; col. 92, ll. 6-15; col. 127, ll. 50-55; col. 132, ll. 50-60; col. 128, ll. 25-45; FIG. 37; FIG. 2A; FIG. 30; FIG. 31; FIG. 44B; FIG. 1; FIG. 17B; FIG. 21; FIG. 46; FIG. 48A; FIG. 47; Fig. 52; FIG. 54; FIG. 58A; col. 101, ll. 60-67; col. 102, ll. 1-67; col. 103, ll. 1-67; col. 104, ll. 1-67; col. 105, ll. 1-67; col. 106, ll. 1-67; col.

Serial Number: 09/777,098

(Bernstein)

Art Unit: 3622

107, ll. 1-67; col. 108, ll. 1-67; col. 109, ll. 1-67; col. 110, ll. 1-67; col. 111, ll. 1-40; and whole document) suggests the elements and limitations of claims 2-8.

Deaton lacks an explicit recitation of the elements and limitations of claims 2-8 even though Deaton (col. 69, ll. 13-22; col. 92, ll. 6-15; col. 127, ll. 50-55; col. 132, ll. 50-60; col. 128, ll. 25-45; FIG. 37; FIG. 2A; FIG. 30; FIG. 31; FIG. 44B; FIG. 1; FIG. 17B; FIG. 21; FIG. 46; FIG. 48A; FIG. 47; Fig. 52; FIG. 54; FIG. 58A; col. 101, ll. 60-67; col. 102, ll. 1-67; col. 103, ll. 1-67; col. 104, ll. 1-67; col. 105, ll. 1-67; col. 106, ll. 1-67; col. 107, ll. 1-67; col. 108, ll. 1-67; col. 109, ll. 1-67; col. 110, ll. 1-67; col. 111, ll. 1-40; and whole document) suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 2-8 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 2-8, because selection/modification of the disclosure of Deaton (col. 69, ll. 13-22; col. 92, ll. 6-15; col. 127, ll. 50-55; col. 132, ll. 50-60; col. 128, ll. 25-45; FIG. 37; FIG. 2A; FIG. 30; FIG. 31; FIG. 44B; FIG. 1; FIG. 17B; FIG. 21; FIG. 46; FIG. 48A; FIG. 47; Fig. 52; FIG. 54; FIG. 58A; col. 101, ll. 60-67; col. 102, ll. 1-67; col. 103, ll. 1-67; col. 104, ll. 1-67; col. 105, ll. 1-67; col. 106, ll. 1-67; col. 107, ll. 1-67; col. 108, ll. 1-67; col. 109, ll. 1-67; col. 110, ll. 1-67; col. 111, ll. 1-40; and whole document) would have provided means for conducting "*differentiated customer promotion. . . .*" (See Deaton (col. 1, ll. 48-67)).

Serial Number: 09/777,098

(Bernstein)

Art Unit: 3622

Independent claim 9 is rejected for substantially the same reasons as independent claim 1.

Dependent claims 10-16 are rejected for substantially the same reasons as dependent claims 2-8.

Independent claim 17 is rejected for substantially the same reasons as independent claim 1.

As per claims 18-22, Deaton shows the method of claim 17 and subsequent claims depending from claim 17.

Deaton (col. 69, ll. 13-22; col. 92, ll. 6-15; col. 127, ll. 50-55; col. 132, ll. 50-60; col. 128, ll. 25-45; FIG. 37; FIG. 2A; FIG. 30; FIG. 31; FIG. 44B; FIG. 1; FIG. 17B; FIG. 21; FIG. 46; FIG. 48A; FIG. 47; Fig. 52; FIG. 54; FIG. 58A; col. 101, ll. 60-67; col. 102, ll. 1-67; col. 103, ll. 1-67; col. 104, ll. 1-67; col. 105, ll. 1-67; col. 106, ll. 1-67; col. 107, ll. 1-67; col. 108, ll. 1-67; col. 109, ll. 1-67; col. 110, ll. 1-67; col. 111, ll. 1-40; and whole document) suggests the elements and limitations of claims 18-22.

Deaton lacks an explicit recitation of the elements and limitations of claims 18-22 even though Deaton (col. 69, ll. 13-22; col. 92, ll. 6-15; col. 127, ll. 50-55; col. 132, ll. 50-60; col. 128, ll. 25-45; FIG. 37; FIG. 2A; FIG. 30; FIG. 31; FIG. 44B; FIG. 1; FIG. 17B; FIG. 21; FIG. 46; FIG. 48A; FIG. 47; Fig. 52; FIG. 54; FIG. 58A; col. 101, ll. 60-

Serial Number: 09/777,098

(Bernstein)

Art Unit: 3622

67; col. 102, ll. 1-67; col. 103, ll. 1-67; col. 104, ll. 1-67; col. 105, ll. 1-67; col. 106, ll. 1-67; col. 107, ll. 1-67; col. 108, ll. 1-67; col. 109, ll. 1-67; col. 110, ll. 1-67; col. 111, ll. 1-40; and whole document) suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 18-22 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 18-22, because selection/modification of the disclosure of Deaton (col. 69, ll. 13-22; col. 92, ll. 6-15; col. 127, ll. 50-55; col. 132, ll. 50-60; col. 128, ll. 25-45; FIG. 37; FIG. 2A; FIG. 30; FIG. 31; FIG. 44B; FIG. 1; FIG. 17B; FIG. 21; FIG. 46; FIG. 48A; FIG. 47; Fig. 52; FIG. 54; FIG. 58A; col. 101, ll. 60-67; col. 102, ll. 1-67; col. 103, ll. 1-67; col. 104, ll. 1-67; col. 105, ll. 1-67; col. 106, ll. 1-67; col. 107, ll. 1-67; col. 108, ll. 1-67; col. 109, ll. 1-67; col. 110, ll. 1-67; col. 111, ll. 1-40; and whole document) would have provided means for conducting "*differentiated customer promotion. . . .*" (See Deaton (col. 1, ll. 48-67)).

Application/Control Number: 09/777,098
Art Unit: 3622

CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:
(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or
(703) 746-7239 (for formal communications marked AFTER-FINAL) or
(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist
Crystal Park V

2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

Application/Control Number: 09/777,098
Art Unit: 3622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Primary Patent Examiner

March 8, 2004